

REMARKS

Applicants first note that the deadline for response, without an extension of time fell on Sunday, September 9, 2007.

Accordingly, this paper is timely filed on Monday, September 10, 2007.

The paper stated in part:

. . . claims 35,41 were rejected under 35 U.S.C. 103(a) as being unpatentable over White (5,996,071) in view of Smith (4,370,711) and claims 38-43 were rejected under 35 U.S.C. 103(a) as being unpatentable over White (5,996,071) in view of Chang (5,687,360). The reasons of obviousness were also given. However, no response or discussions regarding Smith and Chang can be found in applicant's response. In applicant's remark, applicant only [Sic] "the additional material relied upon from secondary reference does not correct the deficiencies of White with respect to the independent claims from which these claims depend." No specific discussions regarding the "secondary reference" can be found in applicant's remarks. Therefore, ii[Sic] is nonresponsive amendment.

Applicants first note that only claims 38 and 43 and not 38-43 (as indicated in the above quotation) were rejected as obvious. In particular, the original rejection stated in part:

As to claims 38, 43, limitations of parent claims have been discussed above. White did not specifically show the shift register for the branch history as claimed. However, Chang disclosed a shift register for a branch history (col.4, lines 38-45).

Further, Applicants expressly considered Claims 38 and 43 when it was stated:

Claims 8, 13, 29, 35, 38, 41 and 43 stand rejected under 35 U.S.C. 103(a). Assuming that the combination of references is correct for each of these claims, the additional material relied upon from the secondary reference does not correct the deficiencies of White with respect to the independent claims from which these claims depend. Therefore, each of Claims 8, 13, 29, 35, 38, 41 and 43 distinguish over the combination of references for

at least the same reasons as the independent claims. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 8, 13, 29, 35, 38, 41 and 43. (All Emphasis Added.)

First, Claim 38 recites:

38. (Original) The branch predictor of claim 33 wherein the branch prediction qualifier entries host one or more bits that indicate one or more of confidence, strength, and validity of branch direction indications.

The rejection mischaracterized express claim limitations as simply a "shift register for the branch history." Since express claim limitations were not considered, a *prima facie* obviousness rejection was not made and so Applicants were under no obligation to respond with respect to Claim 38. "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP 2142, pg. 2100-125. Therefore, the above quoted response was unnecessary, but was nevertheless provided.

Claim 38 depends from Claim 33 and Claim 43 depends from Claim 39. In the response, Applicants pointed out numerous deficiencies of the primary reference, White, with respect to all the independent claims including independent Claims 33 and 39.

The above quoted response indicated that assuming that Chang was characterized correctly in the rejection and teaches a shift register for a branch history, and assuming that the combination of White and Chang is correct, using knowledge about a shift register for a branch history fails to correct the problems with the primary reference, White, with respect to Claims 33 and 39, respectively as noted with respect to the independent claim from which each of these claims depends. Accordingly, a *prima facie* obviousness rejection for Claims 38 and 43 has not been made. Applicants respectfully request

reconsideration and withdrawal of the obviousness rejection of each of Claims 38 and 43.

With respect to Claims 35, 41 the original rejection stated in part:

White did not specifically show hashed address as claimed. However, Smith taught a hashed address (see col.8 lines 10-25).

Claim 35 depends from Claim 33 and Claim 41 depends from Claims 39 and 40. In the portion of response quoted above, Applicants pointed out numerous deficiencies of the primary reference, White, with respect to all the independent claims including independent Claims 33 and 39. The above quoted response indicated that assuming that Smith was characterized correctly in the rejection and teaches a hashed address, and assuming that the combination of White and Smith is correct, using knowledge about a hashed address fails to correct the problems with the primary reference, White, with respect to Claims 35 and 41, respectively as noted with respect to the independent claim from which each depends. Accordingly, a prima facie obviousness rejection for Claims 35 and 41 has not been made. Applicants respectfully request reconsideration and withdrawal of the obviousness rejection of each of Claims 35 and 41.

Applicants respectfully request reconsideration and withdrawal of the notice of non-responsiveness. While Applicants chose to eliminate repetitive and redundant remarks for each of the Claims at issue, this does not make the response non-responsive. Applicants clearly and unambiguously identified why the combination failed to render the invention obvious for each claim and this is all that is required.

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Claims 1 to 44 remain in the application. For the foregoing reasons, Applicants respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 10, 2007.



Attorney for Applicant(s)

September 10, 2007
Date of Signature

Respectfully submitted,



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